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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,979	01/23/2004	John E. Remmers	003-51CIP	5990

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EXAMINER

MITCHELL, TEENA KAY

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,979

Applicant(s)

REMMERS ET AL.

Examiner

Teena Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21-31, 36-45, 47-49, 51-58, 60-64, 77-80, 82-89 and 91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21-31, 36-45, 47-49, 51-58, 60-64, 77-80, 82-89 and 91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Priority***

While applicant in the first paragraph of the specification has listed that the instant application is a Continuation-in-Part of application 09/498,504 applicant failed to note the current status, which is now US Patent 6,752,150. Correction if required.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

While the examiner has reviewed all listed references from application 09/498,504 should applicant want such references listed on any patent that may result from the instant application, applicant is required to submit the proper PTO 1449 form listing such references.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: computer 224. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures

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appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the leak resistant interface of an oral interface and nasal occlusion device are not depicted together in use in one figure, there is depicted an oral interface and a clamp but not the two devices in use together must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In Figure 19 reference numeral 220 line is pointing to the tube not the mask as outlined in the disclosure. Either reference numeral 220 in Figure 19 should be corrected to point to the mask or the disclosure should be amended such that reference numeral depicts the tube not the mask in the disclosure. Correction is required.

Specification

The disclosure is objected to because of the following informalities: On page 12, line 2, "exit 64..." however in the figures reference numeral 64 is directed to the patient interface not an exit (Note Fig. 4A).

Correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19, 21-31, 36-45, 47-49, 51-58, 60-64, 77-80, 82-89, and 91 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 12, 13, 16-19, 24, 27, 30-44, 46-61, 72-74, and 76-82 respectively of U.S. Patent No. 6,752,150 in view of Haydu (4,757,813).

With respect to claim 1 of the instant application, the limitations can be found in claim 1 of patent '150, while patent '150 does not specifically state that the mask is leak resistant it is well known in the respiratory art that mask used in devices for treating a breathing disorder are leak resistant so that appropriate gas can be given to a user. However, if for any reason that '150 patent claim 1 may not be readable upon a leak resistant mask, resort is had to Haydu who teaches a mouthpiece and nose clip (16, Fig. 7) providing a mask that assures that breathing will be done through the mouth when the device is in use (Col. 2, lines 10-14). It would have been obvious to one of ordinary skill in the art to modify the mask of Remmers to employ any well known mouthpiece and nose clip doing so would have provided a means to assure that breathing is done through the mouth when the device is in use thereby providing a leak resistant mask. **With respect to claim 2 of the instant application,** the limitations can be found in claim 12 of patent '150, with respect to the oral interface, and Haydu teaches a nose clip (16). **With respect to claim 3 of the instant application,** the limitations can be found in claim 2 of patent '150. **With respect to claim 4 of the instant application,** the limitations can be found in claim 3 of patent '150. **With respect to claim 5 of the instant application,** the limitations can be found in claim 4 of

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patent '150. **With respect to claim 6 of the instant application**, the limitations can be found in claim 1 of patent '150, note rejection of claim 1 above with respect to the leak resistant mask. **With respect to claim 7 of the instant application**, the limitations can be found in claim 12 of patent '150 and the teaching of Haydu to a nasal occlusion device. **With respect to claim 8 of the instant application**, the limitations can be found in claim 5 of patent '150. **With respect to claim 9 of the instant application**, the limitations can be found in claim 6 of patent '150. **With respect to claim 10 of the instant application**, the limitations can be found in claim 7 of patent '150. **With respect to claim 11 of the instant application**, the limitations can be found in claim 8 of patent '150. **With respect to claim 12 of the instant application**, the limitations can be found in claim 9 of patent '150. **With respect to claim 13 of the instant application**, the limitations can be found in claim 16 of patent '150 and the teaching of Haydu of mouth and nasal occlusion device (i.e., the leak resistant interface). **With respect to claim 14 of the instant application**, the method steps would have been obvious because they would have resulted from the use of the device of patent '150 and the teaching of nasal occlusion device taught by Haydu. **With respect to claim 15 of the instant application**, the limitations can be found in claim 17 of patent '150. **With respect to claim 16 of the instant application**, the limitations can be found in claim 18 of patent '150. **With respect to claim 17 of the instant application**, the limitations can be found in claim 19 of patent '150. **With respect to claim 18 of the instant application**, the limitations can be found in claim 27 of patent '150 and the leak resistant interface taught by Haydu. **With respect to claim 19 of the instant**

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application, the method steps would have been obvious because they would have resulted from the use of the device of patent '150 and the teaching of nasal occlusion device taught by Haydu. **With respect to claim 21 of the instant application**, the limitations can be found in claim 20 of patent '150. **With respect to claim 22 of the instant application**, the limitations can be found in claim 21 of patent '150. **With respect to claim 23 of the instant application**, the limitations can be found in claim 22 of patent '150. **With respect to claim 24 of the instant application**, the limitations can be found in claim 30 of the patent and the teachings of Haydu. **With respect to claim 25 of the instant application**, the limitations can be found in claim 37 and the teachings of Haydu to a nasal occlusion device. **With respect to claim 26 of the instant application**, the limitations can be found in claim 31 of patent '150. **With respect to claim 27 of the instant application**, the limitations can be found in claim 32 of patent '150. **With respect to claim 28 of the instant application**, the limitations can be found in claim 33 of patent '150. **With respect to claim 29 of the instant application**, the limitations can be found in claim 34 of patent '150. **With respect to claim 30 of the instant application**, the limitations can be found in claim 35 of patent '150. **With respect to claim 31 of the instant application**, the limitations can be found in claim 36 of patent '150. **With respect to claim 36 of the instant application**, the limitations can be found in claim 38 of patent '150 and the teachings of Haydu to a leak resistant interface. **With respect to claim 37 of the instant application**, the limitations can be found in claim 38 of patent '150. **With respect to claim 38 of the instant application**, the limitations can be found in claim 39 of patent '150. **With**

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respect to claim 39 of the instant application, the limitations can be found in claim 40 of patent '150. **With respect to claim 40 of the instant application**, the limitations can be found in claim 38 of patent '150. **With respect to claim 41 of the instant application**, the limitations can be found in claim 38 of patent '150. **With respect to claim 42 of the instant application**, the limitations can be found in claim 38 of patent '150. **With respect to claim 43 of the instant application**, the limitations can be found in claim 41 of patent '150. **With respect to claim 44 of the instant application**, the limitations can be found in claim 42 of patent '150. **With respect to claim 45 of the instant application**, the limitations can be found in claims 43 and 44 of patent '150. **With respect to claim 47 of the instant application**, the limitations can be found in claim 46 of patent '150 and the teachings of Haydu to a leak resistant interface. **With respect to claim 48 of the instant application**, note the teachings of Haydu noted above with respect to claim 1. **With respect to claim 49 of the instant application**, the limitations can be found in claim 47 of patent '150. **With respect to claim 51 of the instant application**, the limitations can be found in claim 49 of patent '150. **With respect to claim 52 of the instant application**, the limitations can be found in claim 50 of patent '150. **With respect to claim 53 of the instant application**, the limitations can be found in claim 51 of patent '150. **With respect to claim 54 of the instant application**, the limitations can be found in claim 52 of patent '150. **With respect to claim 55 of the instant application**, the limitations can be found in claim 53 of patent '150. **With respect to claim 56 of the instant application**, the limitations can be found in claim 54 of patent '150 and the teachings of Haydu of a leak resistant interface.

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With respect to claim 57 of the instant application, the method steps would have been obvious because they would have resulted from the use of the device of patent '150 and the teaching of nasal occlusion device taught by Haydu. **With respect to claim 58 of the instant application**, the limitations can be found in claim 55 of patent '150. **With respect to claim 60 of the instant application**, the limitations can be found in claim 54 of patent '150. **With respect to claim 61 of the instant application**, the limitations can be found in claim 57 of patent '150. **With respect to claim 62 of the instant application**, the limitations can be found in claim 58 of patent '150. **With respect to claim 63 of the instant application**, the limitations can be found in claim 59 of patent '150. **With respect to claim 64 of the instant application**, the limitations can be found in claim 60 of patent '150. **With respect to claim 77 of the instant application**, the limitations can be found in claim 72 of patent '150 and the teachings of Haydu of a leak resistant interface. **With respect to claim 78 of the instant application**, the method steps would have been obvious because they would have resulted from the use of the device of patent '150 and the teaching of nasal occlusion device taught by Haydu. **With respect to claim 79 of the instant application**, the limitations can be found in claim 73 of patent '150. **With respect to claim 80 of the instant application**, the limitations can be found in claim 74 of patent '150. **With respect to claim 82 of the instant application**, the limitations can be found in claim 76 of patent '150. **With respect to claim 83 of the instant application**, the limitations can be found in claim 77 of patent '150. **With respect to claim 84 of the instant application**, the limitations can be found in claim 78 of patent '150. **With respect to**

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claim 85 of the instant application, the limitations can be found in claim 79 of patent '150. **With respect to claim 86 of the instant application**, the limitations can be found in claim 80 of patent '150. **With respect to claim 87 of the instant application**, the limitations can be found in claim 81 of patent '150. **With respect to claim 88 of the instant application**, the limitations can be found in claim 82 of patent '150. **With respect to claim 89 of the instant application**, the limitations can be found in claim 10 of patent '150. **With respect to claim 91 of the instant application**, the limitations can be found in claim 24 of application '150.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show breathing devices: 6,814,073; 6,532,959; 6,367,474; 4,674,492; 4,614,186; 2,015,617; 1,270,404.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (571) 272-4798. The examiner can normally be reached on Monday-Friday however the examiner is on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Teena Mitchell
Examiner
Art Unit 3743
February 2, 2005